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Subject: U.S. Trademark Application Serial No. 88712080 - DANICA - 81786.303832 - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 88712080

**Mark:** DANICA

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**Applicant:** Danica Patrick Brands, LLC

**Reference/Docket No.** 81786.303832

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, Danica Patrick Brands LLC, has appealed the examining attorney's final refusal to register the applied-for mark, "DANICA", in standard-character form, under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "Trademark Act"), 15 U.S.C. §1052(d). Registration was refused on the grounds that Applicant's mark is likely to be confused with the standard-character mark, "DANIKA RANCH", in U.S. Registration No. 5262216.

## FACTS

On December 02, 2019, Applicant filed the application at issue to register the mark “DANICA”, in standard-character form, alleging an intent to use the mark in conjunction with “wine” in International Class 033.

On February 03, 2020, the examining attorney issued an Office action refusing registration due to a likelihood of confusion with the mark “DANIKA RANCH” (U.S. Registration No. 5262216), in standard-character form, for “Alcoholic beverages, except beers” in International Class 033.

On August 03, 2020, Applicant responded to the Initial Office Action with arguments in support of registration that were not persuasive enough to overcome the refusal based on Trademark Act Section 2(d) with respect to U.S. Registration No. 5262216. In response, on August 24, 2020, the examining attorney issued a Final Office Action, continuing the likelihood of confusion refusal under Trademark Act Section 2(d).

On February 17, 2021, Applicant responded to the Final Office Action with a request for reconsideration with unpersuasive arguments in support of registration. On March 10, 2021, the examining attorney denied the request for reconsideration.

Applicant filed its appeal brief on June 07, 2021.

## ISSUE

The sole issue for consideration on appeal is whether, under Section 2(d) of the Trademark Act, Applicant's proposed mark “DANICA” so resembles the registrant's mark “DANIKA RANCH” that, when used on or in connection with Applicant's identified goods, there is likelihood of confusion.

## ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the Applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

[Reserved]

- I. **CONFUSION BETWEEN APPLICANT'S MARK, "DANICA", AND REGISTRANT'S MARK, "DANIKA RANCH", IS LIKELY BECAUSE THE MARKS ARE HIGHLY CONFUSINGLY SIMILAR.**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In this case, Applicant’s proposed mark, “DANICA” in standard-character form, is likely to be confused with the registered mark, “DANIKA RANCH”, also in standard-character form. The applied-for and registered marks contain the highly similar wording “DANICA” and “DANIKA” with only registrant’s addition of the disclaimed word “RANCH” to distinguish them. Although Applicant’s mark does not contain the entirety of the registered mark, Applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)).

Merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, Applicant's mark does not create a distinct commercial impression from the registered mark because it contains the dominant wording in the registered mark and does not add any wording that would distinguish it from that mark.

Additionally, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); see also *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"). Thus, the term "DANIKA" in the registered mark creates the dominant commercial impression in the mind of the consumer.

Moreover, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii).

In the present case, the registrant has disclaimed the term “RANCH” because it is common wording for wineries. Therefore, the disclaimed matter further renders the term “DANIKA” to be the dominant term in registrant’s mark.

The entirety of the applied-for mark “DANICA” is highly similar in appearance, and identical in pronunciation with the dominant term “DANIKA” in the registered mark. The only difference between the compared marks is that the letter “K” in the registered mark has been substituted for the letter “C” in the applied-for mark. Consumers would pronounce these letters “K” and “C” in the same way, and thus the dominant term “DANIKA” and the applied-for mark “DANICA” are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Profs, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv). Thus, because the distinctive component of the respective marks are essentially phonetically equivalent, source confusion is likely.

Further, both marks create the overall commercial impression of that of a first name. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Here, both marks contain similar terms, “DANIKA” and “DANICA”, which would be recognized as a first name and therefore are likely to result in source confusion.

In its brief, Applicant first argues that the addition of “RANCH” to the registered mark “DANIKA RANCH” creates a different commercial impression than its mark “DANICA”, relying on *Champagne Louis Roederer, S.A. v. Delicato Vineyards*. Appeal Brief, p. 5 (June 07, 2021), 9 TTABVue 5. However, the facts in the cited case are not equivalent to the facts here, as the “Board found that the word marks “CRISTAL” and “CRYSTAL CREEK” evoked very different images in the minds of relevant consumers: while the former suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter suggested “a very clear (and hence probably remote from civilization) creek or stream.”” *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998), Court Opinion. The term “RANCH” in this case does not modify the term “DANIKA” such that it creates a different commercial impression between the compared marks.

The same issue is present in Applicant’s second example using CANNONBALL CREEK BREWING COMPANY GOLDEN, COLORADO and design mark and CANNONBALL DOUBLE IPA, in that CANNONBALL modifies the term CREEK so as to convey the impression of a particular waterway or stream, whereas CANNONBALL alone is a projectile and thus conveys the impression of a weapon instead of a waterway. In the present case, the term “DANIKA” in the registered mark does not modify the term “RANCH”. On the contrary, the terms “DANICA” and “DANIKA” have the same meaning, that of an individual’s first name. Notably, the commercial impression of the term “DANIKA” as a first name does not change with the addition of the term “RANCH”. The term “DANIKA RANCH” merely appears to be a ranch associated with someone by the first name of “DANIKA”. Consequently, Applicant’s argument that the terms evoke a different commercial impression is ineffective and not sufficient to overcome the likelihood of confusion.

Next, Applicant contends that the term “DANIKA” is not the dominant term in the registered mark, but then notes that the term “RANCH” informs consumers that “95% of the wine must have been produced from primary winemaking material grown on the named ranch.” Appeal Brief, p. 8 (June 07,

2021). These arguments are contradictory. Applicant appears to agree that, with respect to the goods at hand, the term “RANCH” is merely informative about the quality of the wine, admitting that not only is this term common for the type of goods, but that the “average consumer of wine relies on the RANCH term to avoid being deceived.” Appeal Brief, p. 7 (June 07, 2021). However, if consumers are so used to seeing the term “RANCH” in association with wine and alcoholic drink goods and further rely on the informational nature of this term, then this term is inherently not distinctive. Thus, consumers rely on the non-informational term, in the present case “DANIKA”, in identifying the source of Applicant’s goods.

Further, Applicant contends that there is no evidence that consumers are likely to abbreviate the “DANIKA RANCH” mark to “DANIKA”. Appeal Brief, p. 8 (June 07, 2021). However, whether consumers would shorten the registered mark is not the question at hand. The dominant terms in the compared marks are highly visually similar and are phonetically equivalent. The addition of the non-distinctive term “RANCH” does not obviate these similarities. A consumer encountering the compared marks on the concerned goods would likely assume that the goods provided under the “DANICA” mark constitute a new line of goods derived from the same source as the goods provided under the registered mark “DANIKA RANCH”. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant’s marks ALSO ANDREA and ANDREA SPORT were “likely to evoke an association by consumers with opposer’s preexisting mark [ANDREA SIMONE] for its established line of clothing.”). Thus, whether consumers would necessarily shorten the registered mark is irrelevant as the evidence shows that the wording “DANICA” and “DANIKA” create the same overall mental impression of a given name. Ultimately, confusion as to the source is the issue, and it is likely to occur in this case.

Lastly, Applicant contends that consumers will not understand “DANIKA” to mean a given name because “Stag’s Leap did not submit the written consent of a living individual named DANIKA when it applied to register the Cited Mark” and because “[n]one of the Examining Attorney’s evidence, which consisted of four women named Danika, has any connection to “alcoholic beverages, excluding beer”.” Appeal Brief, p. 9-10 (June 07, 2021), 9 TTABVue 9-10. With regards to the registered mark and the two other marks containing the term “DANIKA”, the Applicant contends that the examining attorney who examined the registered mark and the other “DANIKA” marks must not have viewed the term “DANIKA” as a first name since they did not require the Applicants to file a name consent or negative name statement. Applicant’s arguments misstates the USPTO consent and name inquiry requirements. TMEP § 1206.03 states “[i]f the mark comprises a first name, pseudonym, stage name, nickname, surname, or title (e.g., “Mrs. Johnson,” “The Amazing Jeffrey,” or “Aunt Sally”), the examining attorney must determine whether there is evidence that the name identifies an individual who is generally known or is publicly connected with the business in which the mark is used and, as a result, the relevant public would perceive the name as identifying a particular living individual.” All of the “DANIKA” marks cited by Applicant showed only that the marks that comprised a first name; not that this name belonged to an individual who is generally known or publicly connected with the goods. Thus, the lack of name inquiry does not mean, as the Applicant contends, that the examiners did not view the mark as a first name, but merely that, because no one with the name appeared to be associated with the mark based on the evidence, a name inquiry was not warranted based on the TMEP. Moreover, whether a registration has a name consent or negative name statement is not a relevant factor in determining a likelihood of source confusion under Section 2(d).

Further, the fact that none of the women named “DANIKA” in the examining attorney’s evidence are connected to “alcoholic beverages, excluding beer” is irrelevant. That evidence, combined

with the evidence from THE BUMP, BABYNAMES.COM, NAMEBERRY, and BABYNAME WIZARD, merely demonstrates that “DANIKA” is a female first name and would thus have the commercial impression of a first name. Specifically, this evidence includes the following:

- Website excerpt from **THE BUMP** (<https://www.thebump.com/b/danika-baby-name>) demonstrating “DANIKA” as a girl’s name as a variant of Danica and meaning “morning star” from Denmark.<sup>1</sup>
- Website excerpt from **BABYNAMES.COM** (<https://babynames.com/name/danika>) demonstrating “DANIKA” as a female name of Slavic origin meaning “morning star,” and ranking “DANIKA” as the #786 baby name in the U.S. currently.<sup>2</sup>
- Website except from **NAMEBERRY** (<https://nameberry.com/babynome/Danika>) demonstrating “DANIKA” as a girl’s name of eastern European origin meaning “morning star” and listed as a spelling variation of Danica with a modern update.<sup>3</sup>
- Website excerpt from **BABYNAME WIZARD** (<https://www.babynamewizard.com/baby-name/girl/danika>) demonstrating “DANIKA” as a name common to eastern Europeans and listing Danica as a related name.<sup>4</sup>
- Website excerpt from **RICE UNIVERSITY CENTER FOR CIVIC LEADERSHIP** (<https://ccl.rice.edu/staff/danika-burgess-brown-phd>) identifying Danika Burgess Brown as the Director of Curriculum and Fellowships.<sup>5</sup>

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<sup>1</sup> See Reconsideration Letter, pp. 4-7 (March 10, 2021), TSDR pp. 2-5.

<sup>2</sup> See Reconsideration Letter, pp. 8-10 (March 10, 2021), TSDR pp. 6-8.

<sup>3</sup> See Final Office Action, pp. 6-15 (August 24, 2020); TSDR pp. 2-11, Reconsideration Letter, pp. 11 (March 10, 2021), TSDR pp. 9-14.

<sup>4</sup> See Reconsideration Letter, pp. 17-20 (March 10, 2021), TSDR pp. 15-18.

<sup>5</sup> See Reconsideration Letter, pp. 21-22 (March 10, 2021), TSDR pp. 19-20.

- Website excerpt from **UNIVERSITY OF CALIFORNIA - BERKELEY** (<https://ced.berkeley.edu/ced/faculty-staff/danika-cooper>) identifying Danika Cooper as an Assistant Professor of Landscape Architecture and Environmental Planning.<sup>6</sup>
- Website excerpt from **THE DENVER POST** (<https://www.denverpost.com/author/danika-worthington/>) identifying Danika Worthington as a digital strategist for THE KNOW and THE KNOW OUTDOORS.<sup>7</sup>
- Website excerpt from **BETAWORKS VENTURES** (<https://betaworksventures.com/danikalaszuk>) identifying Danika Laszuk as a General Manager.<sup>8</sup>
- Website excerpt from **DANIKABRYSHA.COM** (<https://www.danikabrysha.com/>) identifying Danika Brysha as a self-care coach, CEO of model meals, podcast host, and model.<sup>9</sup>
- Website excerpt from **RIVER ALLIANCE OF WISCONSIN** (<https://wisconsinrivers.org/danika-laine-2/>) identifying Danika Laine as the communications director of the River Alliance of Wisconsin.<sup>10</sup>
- Website excerpt from **BANFIELD PET HOSPITAL** (<https://www.banfield.com/>) identifying Danika McCarthy as a veterinary technician at the Pet Hospital.<sup>11</sup>
- Website excerpt from **RILEY CHILDREN'S HEALTH** (<https://www.rileychildrens.org/find-a-doctor/therapist/danika-hineman>) identifying Danika Hineman as a speech pathologist.<sup>12</sup>
- Website excerpt from **BEMIDJI STATE UNIVERSITY** (<https://bsualumni.org/danika-stelton/>) identifying Danika Stelton as a design technology alumna.<sup>13</sup>

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<sup>6</sup> See Reconsideration Letter, pp. 23-24 (March 10, 2021), TSDR pp. 21-22.

<sup>7</sup> See Reconsideration Letter, pp. 25-28 (March 10, 2021), TSDR pp. 23-26.

<sup>8</sup> See Final Office Action, pp. 31-32 (August 24, 2020), TSDR pp. 27-28; Reconsideration Letter, pp. 29-30 (March 10, 2021), TSDR pp. 27-28.

<sup>9</sup> See Final Office Action, pp. 16-28 (August 24, 2020), TSDR pp. 12-24.

<sup>10</sup> See Final Office Action, pp. 29-30 (August 24, 2020), TSDR pp. 25-26.

<sup>11</sup> See Final Office Action, pp. 33-34 (August 24, 2020), TSDR pp. 29-30.

<sup>12</sup> See Final Office Action, pp. 35-36 (August 24, 2020), TSDR pp. 31-32.

<sup>13</sup> See Final Office Action, pp. 37-39 (August 24, 2020), TSDR pp. 33-35.

- Website excerpt from the **IMBD** movie database ([https://www.imdb.com/name/nm0005211/?ref=nm\\_sr\\_srg\\_0](https://www.imdb.com/name/nm0005211/?ref=nm_sr_srg_0)) identifying Danica McKellar as an actress.<sup>14</sup>
- Website excerpt from **THE BLAST** (<https://theblast.com/c/vanderpump-rules-danica-dow-green-bikini-heat-wave-instagram-firing-rumors-restraining-order/>) identifying Danica Dow as a star from Vanderpump Rules.<sup>15</sup>

Therefore, based on the evidence, consumers would perceive the word “DANIKA” as a first name.

Therefore, because the entirety of the applied-for mark is highly similar to the dominant element of the registered mark, and because both marks create the commercial impression of the same first name, the applied-for mark and registered mark are confusingly similar for purposes of Section 2(d) of the Trademark Act.

## II. **CONFUSION BETWEEN APPLICANT’S MARK, “DANIKA”, AND REGISTRANT’S MARK, “DANIKA RANCH”, IS LIKELY BECAUSE THE GOODS ARE CLOSELY RELATED.**

The goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are

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<sup>14</sup> See Final Office Action, pp. 40-44 (August 24, 2020), TSDR pp. 36-40.

<sup>15</sup> See Final Office Action, pp. 45-55 (August 24, 2020), TSDR pp. 41-51.

such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registration uses broad wording to describe “Alcoholic beverages, except beers”, which presumably encompasses all goods of the type described, including Applicant’s more narrow “wine”. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, Applicant’s and registrant’s goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, Applicant’s and registrant’s goods are related.

In its brief, Applicant contends that the marks travel in different channels of trade because the registrant uses the applied-for mark only on Chardonnay and the Applicant is using the applied-for mark

on a rosé wine. The presumption under Trademark Act Section 7(b) is that the registrant is the owner of the mark and that their use of the mark extends to all goods identified in the registration. 15 U.S.C. §1057(b). In the absence of limitations as to channels of trade or classes of purchasers in the goods in the registration, the presumption is that the goods move in all trade channels normal for such goods and are available to all potential classes of ordinary consumers of such goods. See *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii).

Applicant contends that, since the registrant currently grows only chardonnay grapes, the registrant's actual use is limited to chardonnay based on the Alcohol and Tobacco Tax and Trade Bureau's rules which require that 95% of the grapes used to produce a wine containing the label "RANCH" must come from that ranch. Appeal Brief, p. 12 (June 07, 2021), 9 TTABVue 12. However, determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018). Applicant's extrinsic evidence has no bearing on the scope the goods identified by registrant.

Further, the issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. As demonstrated above, consumers are likely to confuse the marks and both Applicant and registrant have identified legally identical goods. Thus, the issue is not whether consumers could differentiate between chardonnay and rosé wine, but whether consumers would confuse the source of the wines.

Applicant then argues that the refusal is limited to wine because the examining attorney did not provide evidence showing the relatedness of additional liquors. However, the registrant's identification encompasses "all goods of the type described, including Applicant's more narrow use" therefore, additional evidence of other alcoholic beverages is not required. Final Office Action, p. 4 (August 24, 2020), TSDR pp. 1. Thus, the refusal pertains to all alcohols.

Moreover, various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (holding GASPAR'S ALE for beer and ale likely to be confused with JOSE GASPAR GOLD for tequila); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (holding RED BULL for tequila likely to be confused with RED BULL for malt liquor); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261 (TTAB 2011) (holding HB for wine likely to be confused with HB and design for beer); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9 USPQ2d 2069 (TTAB 1989) (holding BRAS D'OR for brandy likely to be confused with BRADOR for beer); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (holding trademark COLAGNAC for cola flavored liqueur likely to be confused with certification mark COGNAC for brandy). Applicant cannot limit the scope of the registrant's identification based on a showing of evidence.

Further, the Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action. See *In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016) (quoting *In re Budge*

*Mfg., Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988)); TBMP §1208 nn.2 & 10. The examining attorney has met the evidentiary burden required for this case.

Finally, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

In sum, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). As a result, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Therefore, because of the highly similar nature of Applicant's and registrant's marks and the related nature of Applicant's and registrant's identified goods, the applied-for mark would create a likelihood of confusion with the cited registered mark.

#### CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register Applicant's proposed mark, "DANICA", for use with "wine" be affirmed on the basis that it is

confusingly similar to registrant's mark, "DANIKA RANCH", in U.S. Registration No. 5262216, for  
"Alcoholic beverages, except beers" under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Respectfully submitted,

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